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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/034,939	03/04/1998	EDWARD B. KNUDSON	UV-42	4035

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EXAMINER

SALCE, JASON P

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/034,939

Applicant(s)

KNUDSON ET AL.

Examiner

Jason P Salce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 103,104,109,110,115,116,121,122,176,177,182 and 183 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 103,104,109,110,115,116,121,122,176,177,182 and 183 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 16.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/20/04 has been entered.

Response to Arguments

2. Applicant's request for reconsideration after the RCE has been considered. Applicant's arguments filed 5/20/04 have been fully considered but they are not persuasive.

In regards to the arguments addressing the "location" limitation, the applicant states, **"with regard to the location in the program guide in which targeted advertisements are displayed or targeted actions are taken, nothing is transmitted from the interactive television program guide to the central facility"**. The examiner notes that claim still does not address transmitting location information from the program guide to the central facility. The claim only states, "monitoring record at the central facility contain the information on which advertisements are displayed" and "maintaining the monitoring record further comprises means for collecting information on the location in the program guide in which each targeted advertisement is displayed in the monitoring record". The collecting step, broadly read, does not imply

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that the location information is transmitted from the program guide to the central facility. At best, the only data transmitted from the program guide is "the information on which advertisements are displayed". The examiner notes that the information on the location where an advertisement was selected must be positively recited as transmitted from the program guide to the central facility.

In regards to the arguments addressing the "reasons" limitation, the applicant states that the demographic data is not a reason. The examiner disagrees and notes that Hendricks teaches that the demographic data consists of the programs viewed by a user on a channel, and the central facility takes this information and sends targeted advertising to a user based on the demographic information (see Column 16, Lines 10-24 and Column 17, Lines 50-56 and Column 27, Lines 17-33 and Column 31, Lines 22-40), therefore the demographic information is the reason why the targeted advertisement is sent. This is consistent with the definition of a reason in the dictionary (www.dictionary.com), which states, "The basis or motive for an action, decision, or conviction".

Therefore, the rejection is stands, and is repeated below.

Claim Objections

3. Claims 103-104, 109-110, 115-116, 121-122, 176-177, and 182-183 are objected to because of the following informalities:

The examiner notes that a program guide is a graphical user interface that is displayed onto a television screen and does not contain the circuitry to transmit information from a subscriber to a central facility. The examiner notes that the

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limitations, which state that the program guide is transmitting the information to a central facility, should state that the client's device (i.e. set top box) is transmitting such data to the central facility. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 103-104, 109-110, 115-116, 121-122, 176-177, and 182-183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks (U.S. Patent No. 5,600,364) in view of Seidman et al. (U.S. Patent No. 6,298,482).

Referring to claim 103, Hendricks discloses monitoring a user's interactions with the interactive television program guide to determine the user's interests (see Column 17, Lines 50-55 for a description of "status reports" that contain information for user access history, which defines a user's programming interests). Also note Column 27, Lines 17-21 for a further discussion of monitoring a subscriber's program access history.

Hendricks also discloses displaying targeted advertising based on the user's interests with the program guide (see Column 30, Lines 35-49 for a description of generated a profile using an algorithm that analyzes the subscriber's program access history, which is used to target a viewer or group of viewers with different advertisements).

Hendricks also discloses monitoring which advertisements are displayed by the program guide (see Column 31, Lines 36-40 for a teaching of the Advertisement Targeting File that contains information on the advertisements that have been chosen by the system as being of the most interest to a specific subscriber). The examiner notes that a network controller 214 monitors the set-top box 220 by transmitting a polling request (Column 26, Lines 27-33). The set-top box 220 then send a status report back to the network controller 214 (Column 27, Lines 17-21).

Hendricks also discloses transmitting information on which advertisements are displayed to a central facility (see Column 17, Lines 50-55 for transmitting a status report from the set-top box 220 to the network controller 214).

Hendricks also discloses maintaining a monitoring record containing information on which advertisements are displayed (again, see Advertisement Targeting File in the Advertisement Scheduling Database 322 at Column 31, Lines 30-40, for a record that is updated from the polling method discussed above, which keeps track of the advertisements that have been displayed).

Hendricks also discloses maintaining information on the location in the program guide in which each targeted advertisement is displayed. The polling method is further discussed at Column 26, Lines 27-32, which explains that when the network controller 214 sends a polling request message to the set-top box 220 that it has a frame format 920 disclosed in Figure 10a. After a set-top box 220 receives the polling request message, the set-top box returns a "status report" (discussed above) and this report has a format disclosed in Figure 10b, which is substantially identical to the frame format 920

in Figure 10a (see Column 27, Lines 50-53). Since the frame format 920 of the "status report" is substantially identical to the polling request made from the network controller 214, at Column 26, Lines 32-33 Hendricks discloses that the frame format 920 may include such program control information as shown in Tables A-C.

Table A specifically discloses a "Menu code" and a "Description" code. The "Menu code" defines a location in the menu (program guide) where the program will be displayed (see Table A and Column 18, Lines 30-35 and Line 49). The "Description" codes are used to define whether there is still or live video available to advertise the program (see Table A and Column 19, Lines 25-27). Therefore, Hendricks discloses maintaining information on the location in the program guide in which each targeted advertisement is displayed. **See arguments above regarding the location limitation.**

Hendricks discloses showing advertisements in a program guide (see Figures 8a-8c), but fails to specifically disclose that advertisements are monitored. Seidman discloses monitoring advertisements as well as programs (see Figure 6 for monitoring the number of commercials viewed and Column 6, Lines 5-8). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the viewer program monitoring system, as taught by Hendricks, to utilize the advertisement monitoring system, as taught by Seidman, for the purpose of spontaneously modifying both the content of the digital stream as well as the association of objects (advertisements for example) in the stream (see Column 2, Lines 27-31 of Seidman).

Referring to claim 104, see rejection of claim 103, but note that instead of maintaining information on the location in the program guide in which each targeted advertisement is displayed, the applicant claims maintaining information on the reasons that the program guide displayed each targeted advertisement. Hendricks further discloses a Viewer Profile database 314 that includes a user's personal profile that consists of demographic information (Column 29, Lines 60-61 and Column 30, Lines 14-15). Hendricks also discloses that any demographic data entered by the viewer (see Column 30, Lines 20-26) will assist the set-top box 220 in targeting advertisements to the viewer (see Column 30, Lines 26-28). Therefore, the demographic information can be considered reasons for displaying targeted advertisements as claimed by the applicant. **See arguments above regarding the definition of a reason.**

Referring to claims 109-110, 115-116, 121-122, 176-177 and 182-183, see rejection of claims 103-104, respectively. Also note that selecting a targeted action by the user is broader than the selection of a targeted advertisement, and is therefore anticipated by the limitation "targeted advertisement".


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 3, 2004


CHRIS GRANT
PRIMARY EXAMINER